

### **REMARKS/ARGUMENTS**

Claims 1-34 are now pending in the application. Claim 1 has been amended to incorporate the limitation of claim 4. Claim 4 has been cancelled. Claims 21-34 have been added with this amendment. The new claims are believed to be wholly supported by the specification and claims as originally filed. Below is a chart which correlates the new claims to the originally filed claims which supports them.

<u>New Claim</u>	<u>Original Claim</u>
21	2
22	9
23	11
24	3
25	12
26	13
27	14
28	5
29	16
30	6
31	17
32	7
33	8
34	18

The present Office Action has indicated that claims 1-14 and 16-18 are rejected. Claims 19 and 20 are allowed. Claim 15 is objected to as being dependent from a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Claims 1-4, 6-14, 17 and 18 stand rejected under 35 USC §102(b) as being anticipated by EP 382,242. The Office Action also indicates that claims 1, 3, 5, 7, 8, 12, 14, 16 and 18 stand rejected under 35 USC §102(b) as being anticipated by EP 552,863. Finally, the Office Action indicates that claims 1, 6-8, 17 and 18 stand rejected under 35 USC §102(b) as being anticipated by U.S. 6,180,575 (Nipe).

Applicants acknowledge the allowance of claims 19 and 20. Claim 1 has been amended to incorporate component (E) an alkali or alkaline earth metal salt of a hydrocarbon-substituted saligenin.

The claims as amended now require that the lubricating composition comprises (A) a base oil, (B) a phosphorus containing compound represented by specific formula and (E) an alkali or alkaline earth metal salt of a hydrocarbon-substituted saligenin. Claim 1 as amended is similar to allowed claim 19 in that component (E) is required by both claims.

EP 382,242 relates to a hydraulic fluid compositions useful for power steering equipment. The composition comprises a phosphorus-containing compound selected from the group consisting of (1) alkyl or alkyl substituted or unsubstituted phenyl phosphorus acid compounds, alkyl or alkyl substituted or unsubstituted phenyl phosphorus thioacid compounds and alkyl or alkyl substituted or unsubstituted phenyl phosphorus dithioacid compounds and (2) one or more thiadiazole derivatives.

EP 382,242 does not teach or suggest the use of an alkali or alkaline earth metal salt of a hydrocarbon-substituted saligenin. Since EP 382,242 does not teach or suggest a required element of the claims, Applicants submit that the claims as amended are now patentable over EP 382,242.

EP 552,863 relates to high sulfur mineral compositions. The compositions comprise a major amount of a base oil of which at least 50% by volume is a mineral oil that has an inherent sulfur content of at least 0.2% by weight which is reduced by adding a small amount of at least one oil-soluble neutral hydrocarbyl phosphite ester. The addition of the phosphite ester improves the copper rod rating in the Cincinnati Milacron Thermal Stability test procedure "A".

EP 552,863 does not teach or suggest a required element of claims. In particular, EP 552,863 does not teach or suggest an alkali or alkaline earth metal salt of a hydrocarbon-substituted saligenin. Since EP 552,863 does not teach or suggest a required element of the claims, Applicants submit that EP 552,863 does not anticipate their claims.

U.S. 6,180,575 (hereinafter Nipe), relates to lubricating oils for gear oils, circulating oils, compressor oils and other applications. Nipe teaches a synergistic combination of additives comprising an adduct of a substituted triazole with an amine phosphate and a trihydrocarbyl phosphate.

Nipe does not teach or suggest a lubricating composition containing an alkali or alkaline earth metal salt of a hydrocarbon-substituted saligenin. Since Nipe does not teach

or suggest a required element of Applicants' claims, Applicants submit that Nipe does not anticipate their claims.

In view of the above comments, Applicants submit that none of the references cited teach or suggest the lubricating compositions specified in the Applicants' claims. Applicants therefore request withdrawal of the rejection and allowance of the claims.

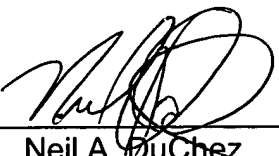
Initialed PTO-1449 Forms

Applicants submitted an Information Disclosure Statement on January 31, 2002 and a Supplemental Information Disclosure Statement on September 27, 2002. To date Applicants have not received initialed copies of the PTO-1449 forms submitted with the statements. Applicants request that the Examiner send such initialed copies to Applicants.

In the event any issues remain in the prosecution of this application, Applicants request that the Examiner call the undersigned attorney to expedite allowance of the claims. If any fees are required for the filing of these papers, Applicants request the Commissioner to charge those fees to Deposit Account #18-0988.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By   
Neil A. DuChez  
Reg. No. 26,725

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113